

REMARKS

Upon entry of the claim amendments, Claims 1-2 and 4-31 will be all the claims pending in the application.

Applicants have added new Claims 27-31. New Claims 27-31 are supported by the description at the first full paragraph at page 10, the first full paragraph at page 15, the first full paragraph at page 16, the second full paragraph at page 16, and the paragraph bridging pages 28 and 29 of the specification.

No new matter has been added.

Referring to the **Office Action Summary** page, Applicants note with appreciation the Examiner's indication that the drawings filed December 5, 2001, have been accepted.

Referring to Section No. 1 at page 2 of the Office Action, the Examiner points out that Claims 8 and 21 are withdrawn from consideration. For the reasons stated at page 1 of the Response filed March 3, 2004, and at page 6 of the Amendment filed September 2, 2004, including the fact that withdrawn Claims 8 and 21 are directed to processes for producing the resin sheets of Claims 1 and 16, respectively, Applicants respectfully request the rejoinder of Claims 8 and 21 upon the allowance of Claims 1 and 16.

Applicants note with appreciation the Examiner's indication at Section No. 3 bridging pages 3 and 4 of the Action that the §103 rejection based on the combination of Sugawa and Oka has been withdrawn.

The Office Action contains a single rejection. Referring to Section No. 2 at pages 2 and 3 of the Action, Claims 1-7, 9-20, and 22-26 are rejected under **35 U.S.C. § 112**, first paragraph, for allegedly being not enabled. According to the Examiner, (i) the gas barrier layer thickness of 2-10 microns, (ii) the peak-to-valley distance of the hard coat layer of 20-80 microns, (iii) the size of the transparent particles of 0.5 to 30 microns, and (iv) the proportion of the transparent particles of from 1-50 vol%, are each critical in practicing the claimed invention. Therefore, the

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Examiner concludes that while a claim containing the above limitations would be enabled, the present claims which exclude the above limitations are not enabled.

Applicants respectfully traverse. The claims are enabled because elements (i), (ii), (iii) and (iv) above are not critical to the practice of the invention.

In determining whether an unclaimed feature is critical, *the entire disclosure must be considered*. Features which are merely preferred are not to be considered critical. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

The specification clearly indicates that elements (i), (ii), (iii) and (iv) above are merely preferred embodiments of the invention. For example, in the first full paragraph at page 10, it is stated that “[t]he thickness of the gas barrier layer is *preferably* from 2 to 10  $\mu\text{m}$ .” In the first full paragraph at page 15 and the paragraph bridging pages 28 and 29, it is stated that “[t]he hard coat layer … *preferably* has a peak-to-valley distance of from 20 to 80  $\mu\text{m}$ .” In the first full paragraph at page 16, it is stated that “[t]he transparent particles *preferably* have a particle diameter of from 0.5 to 30  $\mu\text{m}$ .” In the second full paragraph at page 16, it is stated that “[t]he proportion of the transparent particles to the hard coat layer is *preferably* from 1 to 50% by volume.”

Emphasis is also placed on the Summary of the Invention section of the specification (pages 2-5), wherein the invention is described in language consistent with current independent Claims 1, 2, 10, 11, and 16, and wherein the narrower embodiments alleged by the Examiner to be critical, if even mentioned, are clearly described as being merely preferred.

To demand that Applicants must limit their claims to what they have found will work, or to elements which meet the guidelines specified for “preferred” elements in the absence of limiting prior art, would not serve the constitutional purpose of promoting progress in the useful arts. Goffe, 542 F.2d at 567, 191 USPQ at 431.

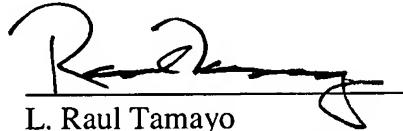
In short, elements (i), (ii), (iii) and (iv) above are merely preferred embodiments of the invention, they are not critical to the practice of the invention, and Claims 1-7, 9-20, and 22-26 are enabled as required by the first paragraph of §112:

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Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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